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EXAMINER

LACOURCIERE, K

ART UNIT	PAPER NUMBER
1635	17

DATE MAILED: 08/31/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

**Office Action Summary**Application No.  
**09/077,817**

Applicant(s)

**Caput et al.**

Examiner

**Karen A. Lacourciere**

Group Art Unit

**1635**

- ☐ Responsive to communication(s) filed on \_\_\_\_\_
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

**Disposition of Claim**

- ☒ Claim(s) 1-43 \_\_\_\_\_ is/are pending in the application.
- Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☒ Claims 1-43 \_\_\_\_\_ are subject to restriction or election requirement.

**Application Papers**

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

- ☒ Notice of References Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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**DETAILED ACTION*****Election/Restrictions***

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claims 1-4, 37 and 39-43, drawn to a polypeptide comprising SEQ ID NO:2.

Group II claims 5-7, 14-17, 25, 29 and 30, drawn to a nucleic acid comprising SEQ ID NO:1.

Group III claims 8-10, 37, 39-43, drawn to a polypeptide comprising SEQ ID NO: 4.

Group IV claims 11-17, 25, 29, and 30, drawn to a nucleic acid comprising SEQ ID NO:3.

Group V claim 24, drawn to an antisense molecule.

Group VI claims 18-20 and 26-28, drawn to a probe targeted to a nucleic acid comprising SEQ ID NO:1.

Group VII claims 21-23 and 26-28, drawn to a probe targeted to a nucleic acid comprising SEQ ID NO:3.

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Group VIII claims 31-34, drawn to an antibody.

Group IX claims 35 and 36, drawn to a modulator and a method of identifying said modulator.

The inventions listed as Groups I-IX do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Claim 36 is drawn to a ligand or modulator of IL-13 receptor, capable of being identified by a claimed method. Culpepper et al. disclose IL-13, a ligand to IL-13 receptor, which is capable of being identified by the claimed method. Claim 36 is not free of the prior art and, therefore, a special technical feature does not link the claims of the instant application.

Further, the inventions of Group I and II are different because they are drawn to materially different products. For example, Group I is drawn to polypeptides, which are composed of amino acids, which are materially different than Group II, which is drawn to nucleic acids, which are composed of nucleotides.

2. The inventions of Groups I and III are different because they are drawn to products which have different functions. For example, the nucleic acids of Group I function to produce IL13-R $\beta$  polypeptides, which is functionally different than the nucleic acids of Group III, which function to produce IL13-R $\alpha$  polypeptides.

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The inventions of Groups I and IV are different because they are drawn to materially different products. For example, Group I is drawn to polypeptides, which are composed of amino acids, which are materially different than Group IV, which is drawn to nucleic acids, which are composed of nucleotides.

The inventions of Group I and V are different because they are drawn to materially different products. For example, Group I is drawn to polypeptides, which are composed of amino acids, which are materially different than Group V, which is drawn to nucleic acids, which are composed of nucleotides.

The inventions of Groups I and VI are different because they are drawn to materially different products. For example, Group I is drawn to polypeptides, which are composed of amino acids, which are materially different than Group VI, which is drawn to nucleic acids, which are composed of nucleotides.

The inventions of Group I and VII are different because they are drawn to materially different products. For example, Group I is drawn to polypeptides, which are composed of amino acids, which are materially different than Group VII, which is drawn to nucleic acids, which are composed of nucleotides.

3. The inventions of Group I and VIII are different because they are drawn to functionally different products. For example, the polypeptides of Group I function as a receptor, whereas the peptides of Group VIII function as antibodies.

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4. The inventions of Group I and IX are different because they are drawn to functionally different products. For example, the polypeptides of Group I function as receptors, whereas the products of Group IX function to modulate the activity of polypeptides.

The inventions of Group II and III are different because they are drawn to materially different products. For example, Group II is drawn to nucleic acids, which are composed of nucleotides, which are materially different than Group IV, which is drawn to polypeptides, which are composed of amino acids.

5. The inventions of Group II and IV are different because they are drawn to functionally different products. For example, the nucleic acids of Group II function to encode an IL13-R $\beta$  polypeptide, whereas The nucleic acids of Group IV function to encode an IL13-R $\alpha$  polypeptide.

6. The inventions of Group II and V are different because they are drawn to nucleic acids which have different functions. For example, the nucleic acids of Group II function by encoding IL13-R $\beta$  polypeptides, which are functionally different than the nucleic acids of Group V, which function as expression inhibitors.

7. The inventions of Group II and VI are different because they are drawn to functionally different products. For example, the nucleic acids of Group II function to encode an IL13-R $\beta$  polypeptide, whereas the nucleic acids of Group VI function to detect a nucleic acid sequence.

8. The inventions of Group II and VII are different because they are drawn to functionally different products. For example, the nucleic acids of Group II function to encode an IL13-R polypeptide, whereas the nucleic acids of Group VII function to detect a nucleic acid sequence.

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9. The inventions of Groups II and VIII are different because they are drawn to materially different products. For example, Group II is drawn to nucleic acids, which are composed of nucleotides, which are materially different than the products of Group VIII, which is drawn to antibodies, which are composed of amino acids.

10. The inventions of Groups II and IX are different because they are drawn to functionally different products. For example, the nucleic acids of Group II function to encode a polypeptide, whereas the products of Group IX function to modulate the activity of polypeptides.

The inventions of Groups III and IV are different because they are drawn to materially different products. For example, Group III is drawn to polypeptides, which are composed of amino acids, which are materially different than Group IV, which is drawn to nucleic acids, which are composed of nucleotides.

The inventions of Groups III and V are different because they are drawn to materially different products. For example, Group III is drawn to polypeptides, which are composed of amino acids, which are materially different than Group V, which is drawn to nucleic acids, which are composed of nucleotides.

The inventions of Groups III and VI are different because they are drawn to materially different products. For example, Group III is drawn to polypeptides, which are composed of amino acids, which are materially different than Group VI, which is drawn to nucleic acids, which are composed of nucleotides.

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The inventions of Groups III and VII are different because they are drawn to materially different products. For example, Group III is drawn to polypeptides, which are composed of amino acids, which are materially different than Group VII, which is drawn to nucleic acids, which are composed of nucleotides.

11. The inventions of Groups III and VIII are different because they are drawn to functionally different products. For example, the polypeptides of Group III function as a receptor, whereas the peptides of Group VIII function as antibodies.

12. The inventions of Groups III and IX are different because they are drawn to functionally different products. For example, the polypeptides of Group III function as receptors, whereas the products of Group IX function to modulate the activity of polypeptides.

13. The inventions of Groups IV and V are different because they are drawn to nucleic acids which have different functions. For example, the nucleic acids of Group IV function by encoding IL13-R $\alpha$  polypeptides, which are functionally different than the nucleic acids of Group V, which function as expression inhibitors.

14. The inventions of Groups IV and VI are different because they are drawn to functionally different products. For example, the nucleic acids of Group IV function to encode an IL13-R $\alpha$  polypeptide, whereas the nucleic acids of Group VI function to detect a nucleic acid sequence.

15. The inventions of Groups IV and VII are different because they are drawn to functionally different products. For example, the nucleic acids of Group IV function to encode an IL13-R $\alpha$  polypeptide, whereas the nucleic acids of Group VII function to detect a nucleic acid sequence.



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16. The inventions of Groups IV and VIII are different because they are drawn to materially different products. For example, Group IV is drawn to nucleic acids, which are composed of nucleotides, which are materially different than the products of Group VIII, which is drawn to antibodies, which are composed of amino acids.

17. The inventions of Groups IV and IX are different because they are drawn to functionally different products. For example, the nucleic acids of Group IV function to encode a polypeptide, whereas the products of Group IX function to modulate the activity of polypeptides.

18. The inventions of Groups V and VI are different because they are drawn to functionally different products. For example, the nucleic acids of Group V function to inhibit the expression of a nucleic acid, whereas the nucleic acids of Group VI function as probes.

The inventions of Groups V and VII are different because they are drawn to functionally different products. For example, the nucleic acids of Group V function to inhibit the expression of a nucleic acid, whereas the nucleic acids of Group VII function as probes.

19. Inventions V and VIII are different because they are drawn to materially different products. For example, Group V is drawn to nucleic acids, which are composed of nucleotides, which are materially different than the products of Group VIII, which is drawn to antibodies, which are composed of amino acids.

20. The inventions of Groups V and IX are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the

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instant case the different inventions are drawn to functionally different products. For example, the antisense molecules of Group V function to inhibit the expression of a nucleic acid, whereas the modulators of Group IX function to modulate the activity of a protein.

21. Inventions VI and VII are different because they are drawn to functionally different products. For example, the nucleic acids of Group VI function to detect a nucleic acid of SEQ ID NO:1, and would have a different structure (ie. nucleotide sequence) than the nucleic acids of Group VII, which function to detect a nucleic acid of SEQ ID NO:3.

22. The inventions of Groups VI and VIII are different because they are drawn to materially different products. For example, Group VI is drawn to nucleic acids, which are composed of nucleotides, which are materially different than the products of Group VIII, which is drawn to antibodies, which are composed of amino acids.

23. The inventions of Groups VI and IX are different because they are drawn to functionally different products. For example, the nucleic acids of Group VI function to detect a nucleic acid sequence, whereas the modulators of Group IX function to modulate the activity of a polypeptide.

24. The inventions of Groups VII and VIII are different because they are drawn to materially different products. For example, Group VII is drawn to nucleic acids, which are composed of nucleotides, which are materially different than the products of Group VIII, which is drawn to antibodies, which are composed of amino acids.

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25. The inventions of Groups VII and IX are different because they are drawn to functionally different products. For example, the nucleic acids of Group VII function to detect a nucleic acid sequence, whereas the modulators of Group IX function to modulate the activity of a polypeptide.

26. The inventions of Groups VIII and IX are different because they are drawn to functionally different products. For example, the antibodies of Group VIII function to bind to epitopes, whereas the modulators of Group IX function by modulating the activity of a polypeptide.

27. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

28. A telephone call was made to Paul Dupont on August 2, 2000 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

29. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

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30. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen A. Lacourciere whose telephone number is (703) 308-7523.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Elliott can be reached at (703) 308-4003. The fax phone number for this Group is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Karen A. Lacourciere

August 29, 2000



SEAN MCGARRY  
PATENT EXAMINER

TC 1600